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Docket #: 29269-2

**PATENT**

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Bonnie S. Jerome

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

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| Applicant: | Gerald W. Ingram et al. | : | Paper No.: |
| Serial No.: | 09/847,999 | : | Group Art Unit: 2177 |
| Filed: | May 4, 2001 | : | Examiner: Pham, Khanh B. |

For: **Method for Adding a Plurality of User Selectable Functions to a Hyperlink**

**REPLY BRIEF**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The present Reply Brief is submitted in response to the Examiner's Answer dated March 23, 2004.

## I. NEWFIELD, GENNARO AND JAIN FAIL TO TEACH, DISCLOSE OR SUGGEST THE NON-LINKING FUNCTIONALITY OF COPYING ANY ASSOCIATED GRAPHICAL IMAGE EMBEDDED IN THE HYPERLINK TO THE SECOND WINDOW

The Examiner's Answer, for the first time, provides detailed comments concerning the Examiner's interpretation of Jain (US 2003/0030679). The Examiner had previously relied on Jain for copying any graphical element associated with the hyperlink, based on his interpretation of the phrase "embedded in the hyperlink". As noted in Paper No. 11, the Examiner asserted that his interpretation of the required claim limitations of copying a

hyperlink and any associated graphical elements corresponding to the hyperlink to a second window, wherein the associated graphical element comprises a graphical image **embedded in the hyperlink**, was "any image associates [sic] with the hyperlink, including the images embedded in the web page where the hyperlink points to, as disclosed by Jain." Now, the Examiner in his Answer Brief has apparently dropped his interpretation of the phrase "embedded in the hyperlink" as also including the target webpage of the hyperlink.

But apparently the Examiner has chosen to ignore the claim limitations of the present invention. As interpreted by the Examiner, the presently claimed invention covers any hyperlink with a graphical image associated with it. However, the present invention requires the step of automatically copying the designated hyperlink and any associated graphical image embedded in the hyperlink to a second window. The Examiner mistakenly relies on Jain for teaching the step of copying a graphical image in the hyperlink to the second window. However, Jain requires the user to manually select **an image** from any location to be associated with the designated hyperlink copied to the second window.

The Examiner in the Examiner's Answer states "images 1002, 1003 are indeed, graphical images embedded in hyperlinks." Applicants do not dispute that images 1002 and 1003 are graphical images embedded in hyperlinks. However, Applicants do dispute that image 1002 is embedded in the hyperlink bookmarked for "http://www.yahoo.com". Specifically, the image 1002 is not the graphical image embedded in the hyperlink which is copied to the second window. The hyperlink copied to the second window is "http://www.yahoo.com". However, image 1002 apparently is embedded in the hyperlink "http://www.yahoo.com/r/wn" linking to the "What's new" webpage rather than the general "www.yahoo.com" webpage. As such, image 1002 is not corresponding to and not embedded in the hyperlink "http://www.yahoo.com".

Jain allows a user to manually add a graphical image to any URL in a bookmark list. this image can be from any source. Whereas, the present invention, automatically copies the hyperlink and any graphical image embedded in the hyperlink to a second window. While image 1002 may be embedded in a hyperlink, it is most definitely not embedded in the hyperlink that is copied to the second window. Thus, the Examiner has failed to teach or disclose the non-linking functionality of copying any associated graphical image embedded in the hyperlink to the second window.

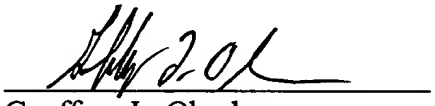
## II. THERE IS NO MOTIVATION OR SUGGESTION TO COMBINE NEWFIELD, GENNARO AND JAIN

When a rejection depends on the combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination. *In re Beattie*, 974 F.2d 1309, 1311-1312, 24 U.S.P.Q.2d 1040, 1042 (Fed. Cir. 1992). Applicants find no teaching, suggestion or motivation for the combination of Newfield, Gennaro and Jain. Gennaro has nothing to do with copying hyperlinks to a second window. Moreover, Newfield teaches away from the Examiner's suggested combination. Newfield specifically teaches away from the combination with Jain, "Bookmarks, however, are often too persistent and place an undesirable management burden on the user." Page 2, 2nd column, 2nd paragraph of Newfield. Jain discloses a method and system for adding a graphical image to bookmarks. "[R]eferences that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1132 (Fed. Cir. 1994). The problems discussed in Newfield relating to bookmarks are still relevant in the bookmarks of Jain. Accordingly, Newfield teaches away from the combination of Newfield with Jain.

## III. CONCLUSIONS

For the reasons set forth in detail above and in view of the arguments set forth in the Appeal Brief filed by certificate of mailing on February 11, 2004, the method of operating a computer defined by claims 31-33 are nonobvious over and patentably distinguishable from Newfield in view of Gennaro, even in further combination with Jain. Accordingly, the rejections of the claims under 35 U.S.C. §103 should be reversed. Favorable action by the Board is respectfully requested.

Respectfully submitted,



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